IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Huan-Cheng Chang et al. Art Unit : 2881
Serial No. : 10/726,071 Examiner : Smith, Johnnie L.
Filed : December 1, 2003
Title : NANOPARTICLE ION DETECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT DATED MARCH 10, 2005

The applicants traverse the 6-way requirement for restriction and provisionally elect claims 30 and 31 for prosecution. The applicants propose that the restriction requirement be modified so that claims 1-23, 27-36, 40-55, and 64-70 in Groups I, II, IV, V, and VI are merged into one group and examined together.

35 U.S.C. § 121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." According to M.P.E.P. 802.01, the meaning of "independent" and "distinct" are as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and

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Sally Hammer
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unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has made no showing whatsoever that the claimed inventions are INDEPENDENT.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." In particular, M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

The claims in Groups I, II, IV, V, and VI can be searched and examined without serious burden because search for prior art related to the claims of Group IV (e.g., claim 30 recites "using an ion trap to collect the ions ejected from the mass selection device; detecting light emitted from the ions in the ion trap") entails search in connection with the claims in Group I (e.g., claim 1 recites "receiving the charged particles at an ion trap, illuminating the charged particles received at the ion trap to induce fluorescence; and detecting the fluorescence.), Group II (e.g., claim 22 recites "illuminating the charged particles received at the ion trap to induce fluorescence, and detecting the fluorescence emitted from the charged particles"), Group V (e.g., claim 32 recites "using an ion trap to reduce speeds of charged particles ...; and detecting fluorescence induced by a laser and emitted from the charged particles"), and Group VI (e.g., claim 54 recites "a laser generator to generate a

laser beam to illuminate the charged particles received at the ion trap to induce fluorescence; and a detector to detect the fluorescence emitted from the charged particles").

The Examiner appears to contend that inventions I, II, IV, V, and VI are related as subcombinations usable together in a single combination. However, this fact has nothing to do with requirements for establishing that the groups I, II, IV, V, and VI are both independent and distinct, and that search and examination of the claims associated with the inventions I, II, IV, V, and VI cannot be made without serious burden. The concession that the groups are related as subcombinations usable together in a single combination compels the conclusion that these groups are not independent.

The applicants note that the examiner has indicated "a shortened statutory period for reply is set to expire 3 months from the mailing date of this communication," so the period for reply expired on June 10, 2005. Enclosed is a petition for two-month extension of time, and a check of $225 for the extension of time fee. Please apply any other charges to deposit account 06-1050, referencing attorney docket 08919-109001.

Respectfully submitted,

Date: 8/10/2005

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** See attached document certifying that Rex Huang has limited recognition to practice before the U.S. Patent and Trademark Office under 37 CFR § 11.9(b).*